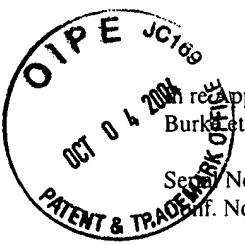


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of
Burke et al
Serial No. 09/998,718
Att. No. 7192

Group Art Unit: 1614

Examiner: Fay, Z.

Filed: November 1, 2001

For: METHODS AND COMPOSITIONS FOR TREATMENT OF
OCULAR NEOVASCULARIZATION AND NEURAL INJURY

PETITION UNDER 37 CFR § 1.181 TO WITHDRAW FINALITY OF OFFICE ACTION

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.181, Applicants hereby respectfully petition the Commissioner to exercise his authority to withdraw the finality of the Office Action dated mailed April 20, 2004 in the above-referenced patent application.

In the previous, non-final Office Action dated September 23, 2004, claims 13-17, 19-20 and 24-25 were subject to a single rejection – an allegation that the claims allegedly violated the written description requirement of 35 USC §112(1). In reply, the Applicants submitted arguments traversing this rejection on December 19, 2003.

The second Office Action purportedly repeated the written description requirement. The April 20, 2004 Office Action responded to Applicant's remarks purported by through a repetition of the written description rejection, but actually based also on a new ground of rejection; that of enablement. Thus, the April 20, 2004 Office Action alleged on page 2 that "the specification does not provide guidance to enable one of ordinary skill in the art to use the invention commensurate in scope with the claims", and on page 3 that "one of skill in the art would be burdened with undue experimentation to determine all compounds which would be able to protect the ocular neural tissue against damage and injury."

MPEP 706.07(a) states a "second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information filed during the period set forth in 37 CFR 1.97(c) . . ."

As Applicants did not amend the claims in their Reply of December 19, 2004, and the current rejection is not a prior art rejection, Applicants responded to both the written description and enablement rejections in the April 20, 2004 Office Action on July 20, 2004; in that communication Applicants also amended the claims for the first time and requested that the Examiner withdrawn the finality of the Office Action.

MPEP 706.07(a) states a "second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information filed during the period set forth in 37 CFR 1.97(c) . . ."

As Applicants did not amend the claims in their Reply of December 19, 2004, and the current rejection is not a prior art rejection, Applicants responded to both the written description and enablement rejections in the April 20, 2004 Office Action on July 20, 2004; in that communication Applicants also amended the claims for the first time and requested that the Examiner withdrawn the finality of the Office Action.

On September 16, 2004 received a one page Advisory Action dated 9/13/04 in which the reply was indicated as not entered as allegedly raising new issues. No other acknowledgement or explanation relating to Applicants' request (or of the "new issues" which were alleged to have been raised) made in this Advisory Action.

Therefore Applicants now petition the Commissioner to exercise his discretion to withdraw the finality of the April 20, 2004 Office Action, and to require the entry of the Amendment filed by the Applicants on July 20, 2004.

As the present case remains under final rejection until the Commissioner's decision on this petition, Applicants are today filing a Notice of Appeal to avoid abandonment of this application. In the event that the present petition is granted, Applicants respectfully request that the application be returned to the examiner for substantive examination in light of the timely-filed July 20, 2004 amendment and that Applicants be refunded the fee associated with filing the Notice of Appeal.

As this Petition is being filed under 37 CFR § 1.181, no fee is thought to be due in connection herewith. However, if Applicants are in error please use Deposit Account 01-0885 for the payment of any fee due regarding this petition.

Respectfully Submitted,

ALLERGAN

Date: 10/11/04

Signature:


Carlos A. Fisher
Registration No. 36,510

Certificate of Mailing

I hereby certify that this correspondence (along with anything referred to as being attached or enclosed herewith) is being deposited on the date indicated below with the U.S. Postal Service as First Class Mail addressed to the Commissioner for Patents, Mail Stop ~~Petition~~ P.O. Box 1450, Alexandria, VA 22313-1450.


Signature of Person Mailing

Printed Name

10/11/04
Date of Mailing



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

17400CIP(AP)

In re Application of
Burke et al

Serial No. 09/998,718
Conf. No. 7192

Filed: November 1, 2001

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COPY

Commissioner for Patents
Alexandria, VA 22313-1450

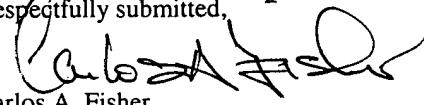
Notice of Appeal

Dear Sir:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the Final Rejection mailed April 20, 2004, of the Primary Examiner finally rejecting claims 13-23.

Please charge our Deposit Account No. 01-0885 in the amount of \$340.00. The Commissioner is hereby authorized to charge payment of any additional fees required or credit any overpayment, to Deposit Account No. 01-0885.

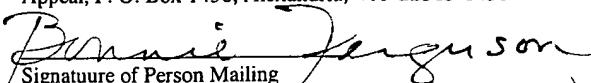
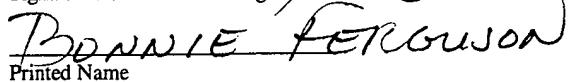
Respectfully submitted,

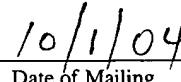

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Telephone: 714-246-4920
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Certificate of Mailing

I hereby certify that this correspondence (along with anything referred to as being attached or enclosed herewith) is being deposited on the date indicated below with the U.S. Postal Service as First Class Mail addressed to the Commissioner for Patents, Mail Stop Notice of Appeal, P. O. Box 1450, Alexandria, VA 22313-1450.


Signature of Person Mailing

Printed Name


Date of Mailing